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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,353	11/26/2001	Erik G. Burrows	2099A	9897

30408 7590 06/08/2005

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EXAMINER

SORRELL, ERON J

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/994,353

Applicant(s)

BURROWS, ERIK G.

Examiner

Eron J. Sorrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

RD

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,4-8,11-15, and 18-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4,6-10,12-16 and 18 of copending Application No. 09/919,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of the instant application have a positive recitation of "receiving a selection of one of said available features from said list," whereas application 09/919,556 necessarily implies a reception of a selected feature in the limitation "analyzing a **selected feature** to be operable from said list (emphasis added)." A

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selection of a feature from a list of features would have to be received before analyzing a selected feature can take place.

The listed dependent claims are identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,2,4-9,11-16,18-23, and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. (US 2003/0028650 hereinafter "Chen").

5. Referring to method claim 1, program on readable medium claim 8, and system claim 15, Chen teaches a method and system for assigning Internet Protocol (IP) addresses, comprising:

identifying hosts present within a local network (see paragraph 76 on page 7);

providing a list of available features for at least one host within said local network (see paragraphs 79-80 of page 7);

receiving a selection of one of said available features from said list (see paragraphs 79-80 of page 7);

analyzing if said selected feature requires a static IP address to be assigned to said at least one host (see paragraphs 79-80 of page 7 and paragraph 85 of page 8); and

assigning an IP address to said at least one host, wherein a static IP address is assigned to said at least one host if said selected feature requires said static IP address (see figures 8 and 14 and paragraph 85 on page 8).

6. Referring to system claim 22, Chen teaches, in a local network of one or more hosts, a system for assigning Internet Protocol (IP) addresses, comprising:

a processor (see item labeled 440 in figure 4);

a memory coupled to said processor, wherein said memory is capable of storing a list of available features for at least one host within the local network (see items labeled 485 and 490 in figure 4);

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a display coupled to said processor, wherein said display is capable of providing said list of available features to a user (see item labeled 450 in figure 4 and figure 8);

an input device coupled to said processor, wherein said input device is capable of receiving a selection by said user of one of said available features from said list (see item labeled 410 in figure 4); and

logic capable of being executed by the processor, wherein said logic is capable of identifying hosts present within a local network, analyzing if said feature selected by said user requires a static IP address to be assigned to said at least one host, and assigning an IP address to said at least one host, wherein a static IP address is assigned to said at least one host if said selected feature requires said static IP address (see paragraphs 79-85 of pages 7 and 8).

7. Referring to method claim 2, program on readable medium claim 9, and system claims 16 and 23, Chen teaches a dynamic IP address is assigned to said at least one host if said selected feature does not require said static IP address to be assigned to said at least one host (see paragraph 86 on page 8).

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8. Referring to method claim 4, program on readable medium claim 11, and system claims 18 and 25, Chen teaches the list is provided in a graphical user interface (see paragraphs 79-80 on page 7).

9. Referring to method claim 5, program on readable medium claim 12, and system claims 19 and 26, Chen teaches the selected feature is capable of being selected by a user utilizing said graphical user interface (see paragraphs 79-80 on page 7).

10. Referring to method claim 6, program on readable medium claim 13, and system claims 20 and 27, Chen teaches the assigning of said IP address is in accordance with Dynamic Host Configuration Protocol (see paragraph 80 if page 7).

11. Referring to method claim 7, program on readable medium claim 14, and system claims 21 and 28, Chen teaches returning the static IP address to a pool of available IP addresses if said selected feature requiring said static IP address is disabled (see paragraph 68 on page 6).

12. Referring to claims 29 and 30, Chen teaches analyzing if the selected feature requires a static IP address is performed

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automatically and without user intervention (see paragraphs 84 and 85; note the connection fields are filled in automatically if there is presumed information available associated with the name of the connection).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3,10,17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Wang et al. (U.S. Patent No. 6,496,511 hereinafter "Wang").

15. Referring to method claim 3, program on readable medium claim 10, and system claims 17 and 24, Chen fails to disclose the limitation the static IP address being assigned from a pool of available static IP addresses and the dynamic IP address is assigned from a pool of available dynamic addresses.



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Wang teaches, in an analogous system and method, the above limitation (see line 50 of column 2 to line 11 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method and system of Chen with the above teachings of Wang. One of ordinary skill in the art would have been motivated to make such modification in order to reserve predetermined IP addresses in a fixed IP address pool for the uses to which they've been assigned as suggested by Wang (see lines 35-47 of column 2).

16. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Chupin et al. (US 2003/0222902 hereinafter "Chupin").

17. Referring to claim 31, Chen fails to the list of available features includes blocking access to the Internet from said at least one host.

Chupin teaches, in an analogous system and method, the above limitation, and teaches that this is useful to block certain users for accessing content on the Internet that may be inappropriate for a particular user (see figure 7 and paragraph 32 on page 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method of Chen with the above teachings of Chupin. One of ordinary skill in the art would have been motivated to make such modification in order to prevent particular users from accessing content on the Internet as suggested by Chupin (see paragraph 32 on page 3).

18. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Favier et al. (US 2002/0129142 hereinafter "Favier").

19. Referring to claim 32, Chen fails to teach the list of available features includes designating the at least one host as a demilitarized zone (DMZ) host.

Favier teaches, in an analogous system, the above limitations (see paragraph 61 and 62 on pages 3 and 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method of Chen with the above teachings of Favier. One of ordinary skill in the art would have been motivated to make such modification in order to allow a network administrator to easily

configure the security components of a network through a GUI as suggested by Favier (see paragraph 29 on page 2).

***Response to Arguments***

20. In the remarks filed on 2/17/05, the applicant stated that claims 1,2,4-9,11-16,18-23 and 25-28, were rejected under 35 USC 102(b) as being anticipated by Chen et al. (US 2003/0028650) in the previous Office Action. This assertion is incorrect, the indicated claims were rejected under 35 USC 102(e).

21. Applicant's arguments filed 2/17/05 have been fully considered but they are not persuasive. The applicant argues:

1) "[T]he Chen system does not analyze if said selected feature requires a static IP address to be assigned to said at least one host and assigning an IP address to said at least one host, wherein a static IP address is assigned to said at least one host if said selected feature requires said static IP address (see paragraph bridging pages 10 and 11 of applicant's remarks and the similar argument is reiterated at the first full paragraph on page 12)."

22. **As per argument 1, the Examiner disagrees.** At paragraphs 84 and 85, Chen discloses that after the name of the connection

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field is completed, the remaining fields including, *inter alia*, the IP address field, are filled in automatically ***if there is presumed information associated with the connection name*** (emphasis added). If there is no presumed information associated with the connection name field, the other fields including the fixed (static) IP address are assigned to the client. Since the client makes some determination as to whether or not there is configuration information available associated with connection name, the system of Chen analyzes if the selected feature required a static IP address to be assigned.

### ***Conclusion***

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J. Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJS  
June 2, 2005



**KIM HUYNH**  
**PRIMARY EXAMINER**

